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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/316,935      05/22/99      MELIEF      C      98-4

ERIC MIRABEZ  
TANOX INC  
10301 STELLA LINK  
HOUSTON TX 77025

HM12/0114

EXAMINER

SORBELLO, E

ART UNIT	PAPER NUMBER
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1633

DATE MAILED:

01/14/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 09/316,935	Applicant(s) MELIEF ET AL.	
	Examiner Eleanor Sorbello	Art Unit 1633	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 0 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-13 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 14) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 17) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 15) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 18) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 16) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 19) <input type="checkbox"/> Other: _____                                    |

Art Unit: \*\*\*

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

I. Claims 1-7 drawn to the composition of the CD40 binding molecule as a protein, and method of treatment of tumors, as classifiable in class 514, subclass 2 and class 530 subclass 350.

II Claims 1-7 drawn to the composition of the CD-40 binding molecule as an antibody, and method of treatment of tumors as classifiable in class 424, subclass 130 .1.

III. Claims 1-7 drawn to the composition of the CD40 binding molecule as an oligonucleotide, and method of treatment of tumors as classifiable in Class 514, subclass 44 and Class 536, subclass 23.1.

IV. Claims 1-7, drawn to the composition of the CD40 binding molecule as an organic molecule, and method of treatment of tumors as classifiable under Class 514, subclass 1+.

V. Claims 8-13, drawn to gene therapy, whereby tumors are treated by means of administering gene constructs coding for a CD40 binding molecule; cells containing gene constructs coding for the CD40 molecule; plasmids or viruses containing the gene constructs coding for the CD40 molecule and classified under Class 514, subclass 44 and Class 435, subclass 325.1.

Art Unit: \*\*\*

**NOTE:** Claims 1-7 appear in multiple groups because these claims encompass multiple inventions. Upon election, applicants should amend the claims to encompass only the elected subject matter.

**NOTE:** Claim 9, specifies the binding molecule is an antibody. However a gene cannot encode an antibody. If applicants intended to claim something other than a method of using a gene then that subject matter would fall into a separate group.

2. Inventions I, II, III, IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the CD40 binding molecule is a protein in Invention I, and an antibody in Invention II, an oligonucleotide in Invention III, an organic molecule in Invention IV, and a gene encoding the binding molecule in Invention V. Each function independently and do not have to be used together to function properly. Each function differently and each is structurally divergent. Hence Invention I is distinct from Invention II is different from Invention III is different from Invention IV, is different from Invention V.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, requiring a different search strategy, restriction for examination purposes as indicated is proper.

Art Unit: \*\*\*

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleanor Sorbello. The examiner can normally be reached on Mondays-Fridays from 7.30 a.m. to 4.00p.m. EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703)-308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
**DEBORAH J. CLARK**  
**PATENT EXAMINER**

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January 13, 2000